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#10

In re Application of:
Thomas, et al
Serial No.: 08/446,804
Filed: June 1, 1995
For: INHALER FOR POWDERED MEDICATIONS

PETITION UNDER 37 CFR 1.181 TO WITHDRAW AN ELECTION OF SPECIES

Applicant's Petition Under 37 CFR 1.181 is Denied

Applicant has petitioned under 37 CFR 181 the election of species (Paper No. 3). Applicant requests the withdrawal of the requirement for election of species on the ground that no statutory base exists for its imposition and requests relief by ordering the withdrawal of the requirement for the election of species.

In response to the election of species, applicant filed a traversal to obtain its withdrawal. The requirement was maintained in Paper No. 6 and the applicant considers the Office's response in Paper No. 6 to be "final" for the purpose of this petition.

Applicant makes the following argument: This application was filed in the U.S. through the Patent Cooperation Treaty under 35 USC 371. Applicant contends that the provisions of 35 USC 121 do not apply to applications filed under 37 USC 171. In further support of this agreement, applicant refers to the following sections of the MPEP 801 and 1895.01(4).

> "This chapter is limited to a discussion of restriction...as it relates to national applications filed under 35 U.S.C. 111. The discussion of unity of invention under the Cooperation Treaty Articles and Rules as it is applied... in applications entering the national Stage under 35 U.S.C. 371 as a designated or elected Office in the Patent and Trademark Office is covered in Chapter 1800.I"
>
> "Restriction practice in both international and national stage application is determined under unity of invention principles as set forth in 37 CFR 1.475 and 1.499. Restriction practice under 37 U.S.C. 121, as it applies to national applications submitted under 35 U.S.C. 111(a), is not applicable to either international or national stage applications."

Applicant in further support of his petition directs attention to the discussion found at 1174 O.G. 32 (May 2, 1995) in announcing the establishment of 37 CFR. 1.124.

> 104. Comment: One comment asked whether "restriction" under Section 1.129(b) apply to election of species under Section 1.146. Response: "Restriction" under Section 1.129(b) applies to both requirements under Section 1.142 and elections under Section 1.146.
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> 110. Comment: One comment suggested that the standard for determining whether an application contains independent and distinct inventions should only be the "unity of invention" standard used for PCT applications. Response: The suggestion has not been adopted. The current restriction practice for 35 U.S.C. 111(a) applications is governed by 35 U.S.C. 121 and Sections 1.141, 1.142 and 1.146. The PCT "unity of invention" standard only applies to PCT applications and applications filed under 35 USC 371.

Thus, applicant concludes that any perceived multiplicity of invention must be dealt with in accordance with 37 CFR 1.475, which establishes a "single general inventive concept" standard for examination of the claims and that any requirement for election of species made in the subject application under 35 USC 121 is improper.

The arguments presented by the petitioner are not found to be persuasive. Firstly, a distinction is drawn between a requirement to elect between distinct inventions and the election of species. Restriction is a generic term that includes election between distinct inventions and election of species. Note section 802.02 of the MPEP. Section 802.02 does not equate an election between distinct inventions and election of species. A detailed discussion of this line of reasoning can be found in the examiner's letter of 3/5/96 (Paper No. 6).

The PCT "unity of invention" standards only applies to PCT applications and applications filed under 35 USC 371. Under current Office practice for applications filed under 35 USC 371, restriction practice for distinct inventions is not governed by 35 USC 121 but rather the Unity of Invention principles as set forth in 37 CFR 1.475 and 1.499. On the other hand, the election of species practice in applications filed under 35 USC 371 is consistent with U.S. practice under 35 USC 121.

If applicant's conclusions were taken to their logical conclusions, the Markush practice in applications filed under 35 USC 371 would cease to exist. It would appear that under the unity standard, all the claimed elements of the Markush Group would have to be searched.

Such is not the case, Applicant's attention is directed to the PCT Administrative Instructions (Annex B/III Markush Practice) - a copy is attached. A reading of the instructions will show that Markush Groupings are permitted. For these reasons applicant's petition is denied.

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JJL:nlw

Enclosures

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